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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,500	01/20/2000	Klaus M. Irion	02581-P0204A	4514

7590

07/14/2003

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EXAMINER

YU, JUSTINE ROMANG

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 07/14/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

ALK

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	09/488,500		IRION, KLAUS M.	
	Examiner		Art Unit	
	Justine R Yu		3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/4/03 has been entered.
2. This office action is responsive to the amendment filed on 4/9/03. As directed by the amendment, claims 1 and 23 were amended; no claim was canceled or added. Thus, claims 1-44 are presently pending in this application.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 13 of claim 1, the term "said tumor specific substance" lacks antecedent basis.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3-14, 19, 23, 25-36, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli (5,350,391) in view of Gain (3,840,015). The combined Iacovelli and Gain reference has everything as claimed (See paragraph 5 of the previous office action). Regarding the light source, the modified Iacovelli reference lacks a detail description that the light source only emits light of specific wavelength ranges matching excitation ranges of both the fluorescent marking of the instrument and the tumor specific substance. However, the feature of choosing such a particular light source is considered as an obvious design choice within the knowledge of one skill in the art, since it appears that the modified Iacovelli's fluorescing substance would perform equally well with the selected light source.

6. Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli in view of Gain as applied to claims 1 and 23 above, and further in view of Richards-Kortum. See paragraph 6 of the previous office action.

7. Claims 12-13 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli in view of Gain as applied to claims 1 and 23 above, and further in view of Sugai. See paragraph 7 of the previous office action.

8. Claims 15-18, 20-22, 37-40, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli in view of Gain as applied to claims 1 and 23 above, and further in view of Nakamura. See paragraph 8 of the previous office action.

*Response to Arguments*

9. Applicant's arguments filed 4/9/03 have been fully considered but they are not persuasive. The applicant on page 8 of the remarks argues that the Iacovelli and Gain use fluorescence to create a contrast between the background tissue and the surgical instrument, and the luminescent markings would be chosen in a way not to coincide with other fluorescence phenomena. The argument is not well taken because there is no basis to support the allegation that the modified Iacovelli luminescent markings must be chosen in a way not to coincide with other fluorescence phenomena, or, the modified Iacovelli's fluorescing substance can not be excited to fluoresce by a light source which is selected in a way that it only emits light of specific wavelength ranges matching excitation ranges of both the fluorescent marking of the instrument and the tumor specific substance or tissue auto-fluorescence as stated in claims 1 and 23. Indeed, choosing such a particular light source is merely a design consideration upon various working environments in the body when using the instrument. In addition, the applicant is reminded that the particular light source in claims 1 and 23 is not even part of the invention. Thus, the modified Iacovelli reference reads on the claim language.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Parker et al (4,541,438) is cited to show different light with wavelengths for exciting tumor specific markers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justine R Yu whose telephone number is (703)308-2675. The examiner can normally be reached on 8:30am - 6:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (703)308-2698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.



Justine R Yu  
Primary Examiner  
Art Unit 3764

JY  
July 9, 2003